



Remarks

The Examiner has rejected claim 10 under 35 USC §112, second paragraph. It is believed the amendment of claim 10 set forth hereinabove renders this rejection moot.

If the Examiner still finds claim 10 nonspecific, he is respectfully requested to suggest wording which he would find suitable.

The Examiner next rejects claims 1 and 2 under 35 USC §102(e), as being anticipated by Blanton. This rejection is respectfully traversed.

The Examiner states:

"Blanton discloses a diffuse lighting arrangement comprising a main power cord having a plug at one end thereof and incorporating a plurality of identical minimally spaced apart strings of spaced apart miniature lights extending from the power cord (Fig 12), the strings of lights are substantially identical in length (Fig 12)."

This opinion rendered by the Examiner is not substantiated by a reading of Blanton.

Reviewing the description of Figure 12 of Blanton (column 9, line 24, et seq), a single light string, draping between his adjacent movable clips, each fixed to a planar base, create an illusion of icicles hanging off the planar base, which planar base is fixed to the eaves of a house, with the plurality of individual, single light strings each being removable, and the base being permanently mounted to the eaves.

Such single strings of spaced apart lights cannot be construed as equivalent to minimally spaced apart strings of spaced apart miniature lights extending from the power cord, with the strings extending from the power cord being equal in length.

The lights of Blanton are on the power cord itself, with no strings of lights extending from the power cord being found, much less hinted at. Further, strings of identical length are not mentioned, because they cannot be.

Viewing decisions in Lincoln Stores, Inc. v. Nashua Manufacturing Company, 70 USPQ 254 (CA 1 1946):

"Earlier disclosures do not anticipate where they afford no more than a starting point and do not teach how to practice new invention."

"Patent does not anticipate where it failed to solve problem which subsequent patent solves successfully."

"Previous adoption of essential element of patent for another and distinct purpose is not anticipation.",

and In re Papesch, 137 USPQ 43 (CCPA 1963)

"From a standpoint of patent law, a product and all of its properties are inseparable; they are one and the same thing. The patentability of the product does not depend on the similarity of its structure to that of another product but of the similarity of the former product to the latter. There is no basis in law for ignoring any property in making such a comparison.",

anticipation cannot be found and the rejection based on 35 USC

§102(e) must be withdrawn.

The Examiner goes on to reject claims 3-7 and 10 under 35 USC 102(a) as unpatentable over Blanton. This anticipation rejection is respectfully traversed.

The Examiner here opines:

"Although Blanton does not disclose the light strings being connected in series or the light strings being electrically connected to the power supply cord in parallel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement these methods of connection and power distribution since they are old and well known in the art as methods of connecting different aspects of electrical (in this case decorative lighting) arrangements in series and/or parallel. Circuit protection devices as a means of protecting the circuitry of lighting devices, specifically Christmas lights, is old and well known in the art for preventing short circuiting due to power surges or weather effects on the lighting devices. The Examiner takes Official Notice of the equivalence of an anchor strap and the clip shown in Figure 10 of Blanton for their use in clasping wire of decorative arrangements or any wire for decorative purposes and the selection of any of these known equivalents to clasping wiring or decorative arrangements would be well within the level of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made make the "anchor" strap adjustable in

length, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954). With regards to claim 10, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987)."

First of all, the Examiner's opinion regarding series connected, parallel aligned light strings extending from a power cord being obvious to one skilled in the art is not well taken.

In this respect, the Blanton reference does not even hint at such a configuration, and would not, inasmuch as the single string of Blanton's lights is engaged by clips to corresponding formations on a necessary planar elongate base member used for mounting the light string via the clips.

One would be hard pressed to see the configuration of Blanton in use on a structure such as a picnic table umbrella, especially in the area circumferentially surrounding the upright pole of the umbrella!

Secondly, it must be remembered that claims 3-9 are dependent from claims 1 and 2, bearing the limitations of those claims and serving to enhance descriptions thereof further.

Since claims 1 and 2 cannot be anticipated by Blanton, as argued above, neither can the claims depending therefrom.

With respect to circuit protection devices being in use with

items substantially identical to that of applicant's, applicant has no knowledge and requires strict proof thereof.

The Official Notice of equivalence between a clip and a strap, as propounded by the Examiner is traversed, with applicant requiring presentation of a reference for this proposition, together with a reason for presentation of such combination and foundation for the alleged equivalence.

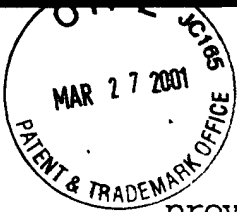
With respect to the alleged obviousness of making applicant's strap adjustable in length, one is hard pressed to follow this line of reasoning since it is only applicant who discloses use of a strap.

Turning to a perusal of In re Stevens, cited by the Examiner, its applicability in the subject application is questioned inasmuch as "adjustability" was disclosed in two cited prior art references, both pertaining to a fishing reel, which taught identical adjustability to the combination invention of Stevens.

In the subject application, no reference showing identical structures has been presented. In re Stevens, accordingly, does not apply here.

With respect to the manner in which an apparatus is to be employed not being differentiable, and the citation of Ex parte Masham to bolster the Examiner's opinion, it must be noted that the apparatus of Masham is a mixing device which had been substantially identically disclosed in a prior art patent to a Williams, the only difference being in instructions of use.

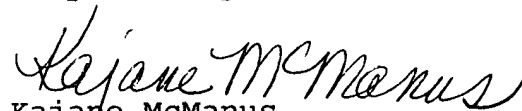
This is not the case here inasmuch as the Examiner has

provided no "structurally" identical prior art. Accordingly, Ex parte Masham has no bearing on this case. Applicant obtains a new result with his structure which is nowhere disclosed in the art cited. Here the Examiner is directed to In re Attwood 148 USPQ 203 (CCPA 1966)

"Counsel for appellant is his brief contends that a case like this invention is to be gauged not alone by the extent or simplicity of the physical changes made, but also by the perception of the necessity or desirability of making such changes to produce a new result. We think that this contention has merit."

Accordingly, based on the above, applicant believes restriction to the claims found allowable by the Examiner would be far too narrow, and awaits early allowance of the claims as they now stand.

Respectfully submitted,


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10. (Amended) For use on a structure including a radial array of a plurality of support ribs extending from a center support thereof, a diffuse lighting arrangement comprising a power supply cord terminating in a plug and having a plurality of identical, minimally spaced apart strings of miniature lights extending therefrom, equal to the plurality of supporting ribs, and an anchor strap engageable at the center of the structure and incorporating a plurality of [power supply cord] anchoring structures which engage the cord to the center support in areas between the spaced apart strings of miniature lights.